

### **REMARKS**

In response to the Notice of Non-Compliance dated April 12, 2007, the claims are amended to provide appropriate designations of the claims. No amendment herein contains new matter.

In order to expedite allowance and to remove issues for consideration, claims 1-25, 30-37, 45-58, 72, and 80-108 have been cancelled without prejudice or disclaimer so that only claims 59-71 and 73-79 remain pending. It is emphasized that the cancellation is without prejudice or disclaimer and that applicants reserve the right to prosecute claims of the same or broader scope than the cancelled claims in this or another application (e.g., a continuing application).

Regarding independent claims 59, 66, and 73, claim 59 stands rejected under 35 U.S.C. §102(b) over U. S. Patent No. 5,155,401 to Kanaya et al. ("Kanaya"), claim 66 stands rejected under 35 U.S.C. §102(b) over Kanaya and claim 73 stands rejected under 35 U.S.C. §102(e) over U. S. Patent No. 5,753,908 to Christensen ("Christensen").

According to MPEP §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Regarding the rejection over Kanaya, the Kanaya reference shows and describes a recorder motor having a coded disk 32 secured to the motor shaft with an image sensor 33 in close proximity thereto for detecting the rotational angle of the coded disk 32. The positioning of the coded disk 32 relative to the coded sensor 33 is accomplished by selectively positioning the coded disk 32 on the motor shaft, and by selectively positioning, and soldering, both the sensor 33 with respect to a circuit board 35, and the circuit board 35 with respect to the motor terminals 28 and 29.

Referring now to the Examiner's objections on the basis of Kanaya, the Examiner refers to the motor terminals 28 and 29 as being the solder receiving

interface between the printed circuit and the optical subassembly. Accordingly, the optical subassembly must include not only the disk 32 and its carrying shaft 17, but also the receiving member 39, the shaft 17, the bearings 15 and 16, the rotor 18, the rotor magnets 19, and the excitation coils 20 and 21. Inasmuch as these various elements are relatively moveable and not collectively rigid, the soldering of the circuit board 35 to the motor terminals 28 and 29 does not ensure that there will be no movement between the disk 32 and the image sensor 33.

Referring now to claim 59 and 66 as amended, the optical subassembly is recited as being substantially rigid, thus ensuring that once the two subassemblies are soldered together, there will be no movement between the image sensor and the optical element. This is to be contrasted with Kanaya wherein the structure between the motor terminals 28 and 29 and the disk 32 is relatively moveable.

In respect to claims 59 and 61, the Examiner suggests Kanaya, has a substantially rigid optical subassembly, even though it includes a disk 32, a carrying shaft 19, receiving member 39, a shaft 17, bearings 15 and 16, a rotor 18, a rotor magnet 19 and excitation coils 20 and 21. The applicants believe that inasmuch as these elements are flexibly interconnected such that one part moves with respect to the other, they are not collectively a rigid subassembly. In view of the above, applicants respectfully assert that the Examiner has not established a *prima facie* case of anticipation as to claims 59 and 66.

Turning now to the rejections of claim 73 under 35 U.S.C. §102(e) over Christensen, the Christensen reference shows an imaging device including a retina board 80 upon which a linear photo sensor array 52 is mounted, with the board 80 being attached by screws 24 to a scanning carriage 10 that include lenses 20 and 22. The screws 24 pass through a pair of over sized holes 82 and 84 in the board 80 such that the board 80 can move relative to the scanning carriage 10 to allow adjustments for the first, second and third degrees of freedom as shown at 30, 32 and 34 of Fig. 5. As will be seen in Fig. 6, adjustments of the focus between the lens 22 and the photo sensor array 52 is made by moving the lens 22 in a fourth degree of freedom 36. Adjustment in the fifth degree of freedom 38 is obtained by

movement of the retina board 50 by adjusting the screws 150 and 152. Of the five degrees of freedom, it is thus only the fourth degree of freedom which is comparable to the present invention, and as described hereinabove, Christensen only suggest that the lens 22 be positionally adjusted with respect to the photo sensor array 52. But he does not describe or suggest how that is accomplished or how those elements are positioned and fixed in place.

With regard to the 35 U.S.C. §102(e) rejections on the basis of Christensen, as set forth in paragraph 9 of the Office Action, the Examiner appears to be stating that the printed circuit board 80 is a part of the optical subassembly 10. If one chooses this construction, then, as shown in Fig. 4, the sockets 90 and 100 which are soldered into the printed circuit board 80, must also be considered part of the "optical subassembly". Then, there is no "solder receiving interface between the substantially rigid planar member and the optical subassembly" as suggested by the Examiner. The interface is rather by a way of "Pins in Carrier Type IC Socket" arrangement as described in lines 33-47 of column 5. That is, the solder interface is on the "optical subassembly" as defined by the Examiner, but it is not "between" the rigid planar member and the optical subassembly as recited in the applicant's claims.

In view of the above, applicants respectfully assert that the Examiner has not established a *prima facie* case of anticipation as to claim 73.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the January 8, 2003 Office action, that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. Applicants expressly reserve the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

While the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part

of an Examiner, the applicants highlighting of a particular claim element for such purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

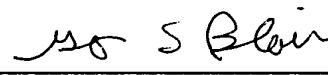
Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: May 11, 2007

Respectfully submitted,

By   
George S. Blasiak  
Registration No.: 37,283  
MARJAMA & BILINSKI LLP  
250 South Clinton Street  
Suite 300  
Syracuse, New York 13202  
(315) 425-9000  
Customer No. 20874

GSB/bs